



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/616,247	07/14/2000	Dennis A. Carson	30448.80USD2	6658

7590 08/25/2004

LISA A. HAILE, PH.D.
GRAY CARY WARE AND FREIDENRICH LLP
4365 EXECUTIVE DRIVE
SUITE 1600
SAN DIEGO, CA 92121

EXAMINER

SHAHNAN SHAH, KHATOL S

ART UNIT PAPER NUMBER

1645

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/616,247

Applicant(s)

CARSON ET AL.

Examiner

Khatol S Shahn-Shah

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,18,19,22-24 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,18,22 and 32 is/are rejected.
- 7) ☒ Claim(s) 19, 23, 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/6/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants' amendments and response received 3/01/2004 is acknowledged. Claims 10, 18, 19 and 22-24 have been amended. Claims 20-21 have been canceled.
2. Currently claims 10, 18, 19, 22-24 and 32 are pending and under consideration.

Prior Citations of Title 35 Sections

3. The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior office action.

Prior Citations of References

4. The references cited or used as prior art in support of one or more rejections in the instant office action have been previously cited and made of record. No form PTO-892 has been submitted with this office action.

Information Disclosure Statement

5. Applicants' Information disclosure statement of 10/06/2003 is acknowledged. The references have considered by the examiner. See attached PTO 1449.

Rejection(s) Moot

6. Rejection of claim 20 made in paragraph 13 of the office action mailed 6/30/ 2003 is moot in view of cancellation of said claim.

Rejection(s) Withdrawn

7. Rejection of claims 18-19 and 23-24 made in paragraph 11 of the office action mailed 6/30/ 2003 is withdrawn in view of applicants' amendment.

8. Rejection of claims 10, 22 and 32 made in paragraph 9 of the office action mailed 6/30/03 is withdrawn in view of applicants' arguments.

9. Rejection of claims 10, 18, 22 and 32 made in paragraph 13 of the office action mailed 6/30/03 is withdrawn in view of applicants' amendments.

New Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 10, 18, 20, 22 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Bardwell et al. (Accession # HHECDJ and The Journal of Biological Chemistry, Vol. 261, No: 4, pp. 1782-1185, 1986). Prior art of record.

The claims are drawn to an isolated polynucleotide, which encodes dnaJpl peptide having the amino acid sequence of SEQ ID NO: 4.

Bardwell et al. teach an isolated polynucleotide produced by E.coli, which encodes dnaJp peptide having the amino acid sequence of SEQ ID NO: 4. (See sequence alignment # HHECDJ, and title, abstract in page 1782). Bardwell et al. also teach recombinant gene expression vectors (see page 1783 under results). Bardwell teach the full-length nucleic acid sequence and fragments (see page 1783 and figure 1) including positions 181-225 (i.e. SEQ ID NO: 4). Bardwell et al. specifically do not teach an **isolated** fragment consisting essentially of

SEQ ID NO: 4. However, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to isolate the specific peptide from positions 181-225.

One of the ordinary skill in the art would have been motivated by the teaching of Bardwell et al. to isolate different fragments (see page 1783).

Conclusion

10. No claims are allowed.

Claims 10, 18, 22 and 32 stand rejected.

Claims 19, 23, 24 are objected to as being depended from rejected claims 18 and 32.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

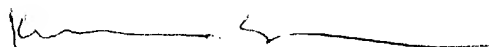
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khatol S Shannan-Shah whose telephone number is (571)-272-0863. The examiner can normally be reached on 7:30am-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F Smith can be reached on (571)-272-0864. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

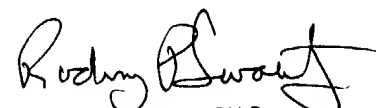


Khatol Shahnan-Shah, BS, Pharm, MS

Biotechnology Patent Examiner

Art Unit 1645

August 21, 2004



RODNEY P. SWARTZ, PH.D.
PRIMARY EXAMINER